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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,660	07/26/2000	Frederick L. Merritt	0250W/00003U	6309
24350	7590	12/19/2003	EXAMINER	
STITES & HARBISON, PLLC 400 W MARKET ST SUITE 1800 LOUISVILLE, KY 40202-3352			DURAN, ARTHUR D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/625,660

Applicant(s)

MERRITT, FREDERICK L.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-14 have been examined.

***Response to Amendment***

2. The Amendment filed on 12/10/03 is insufficient to overcome the Eggleston and Dedrick reference.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston (6,061,660) in view of Dedrick (5,724,521).

Claim 1, 9, 10, 11, 12, 14: Eggleston discloses a system, network for re-directing users of a global information network to specific advertisements resident on said network, wherein said system includes a sweepstakes component, comprising:

a first database storing and maintaining identifying information related to a plurality of users, said users having registered with the system and being classified as a sweepstakes player, a prize presenter, or an advertiser (col 10, lines 1-10). Eggleston discloses that retailer's register

and that retailer's can be advertisers (col 13, line 65-col 14, line 5; col 1, lines 35-40; col 10, lines 1-10).

Eggleston further discloses a second database storing and maintaining information related to a plurality of prizes to be distributed through the sweepstakes component of the system, each of said prizes being associated with a prize presenter registered with the system (col 14, line 65-col 15, line 15); and

a third database storing and maintaining target advertising profiles, each of said profiles being associated with an advertiser registered with the system (col 42, lines 35-40). Eggleston further discloses that the sponsor can also be an advertiser (col 34, lines 41-46; col 21, lines 14-18).

Eggleston further discloses that when a sweepstakes player enters a sweepstakes for a particular prize, the identifying information related to said sweepstakes player stored and maintained in said first database is compared to the target advertising profiles stored and maintained in said third database (col 42, lines 31-40; col 41, lines 55-65).

Eggleston further discloses that said user is directed to a specific program of a particular advertiser registered with the system based on said comparison (col 31, lines 35-40; col 42, lines 35-40).

Eggleston does not explicitly state that the user is directed to the advertising based on the comparison.

However, Eggleston further discloses that the incentives information can include advertising (col 34, lines 41-47). Eggleston further discloses directing the user to advertising (col 1, lines 36-41) and targeting the user to particular programs (col 31, lines 35-40; col 42, lines 35-40).

Therefore, it would be obvious to Eggleston that the advertising the user is directed to can be targeted. One would have been motivated to do this so that the user goes to a site they are more likely interested in.

Eggleston further discloses profiling or targeting a user (col 31, lines 35-40; col 42, lines 35-40), directing the player to advertising (col 1, lines 35-41).

Eggleston does not explicitly disclose that said particular advertiser pays a predetermined amount for the directing of said sweepstakes player to the specific advertisement.

However, Dedrick discloses playing games (col 2, lines 61-64) and charging for directing a user to advertising (col 2, lines 5-10);

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Dedrick's charging for directing advertising to Eggleston's directing user's to advertisements. One would have been motivated to do this because it is targeted users are of interest to advertisers.

Eggleston does not explicitly disclose that the prize can be delivered once the cost of that prize or a surplus of that cost has been satisfied.

However, Eggleston further discloses distributing a particular prize once a predetermined threshold is met (col 30, line 65-col 31, line 5). Eggleston further discloses that prizes cost money (col 15, lines 6-15). Eggleston further discloses tracking sponsor expenses (col 39, lines 40-51).

Therefore, in light of Eggleston being able to charge for directing advertising as disclosed above, it would have been obvious to Eggleston to offer the prize once the cost of the prize has

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been satisfied. One would have been motivated to do this so that the sponsor can assure that their expenses are well maintained.

Eggleston further discloses that the advertisements can be located on websites each associated with one of said registered advertisers (col 1, lines 35-40; col 8, lines 30-43) and a particular advertising profile (col 30, lines 25-30; col 13, line 65-col 14, line 5; col 31, lines 35-40; col 42, lines 35-40).

Eggleston further discloses collecting demographic information on the player (col 13, lines 5-27).

Eggleston further discloses the prize presenter disclosing a selling price for each prize (col 15, lines 3-15; col 42, lines 33-40).

Eggleston further discloses the player selecting a prize (col 26, lines 10-19).

Eggleston further discloses that the retailer and the sponsor can be the same (col 21, lines 14-18) or different (col 10, lines 1-10).

Claim 2: Eggleston and Dedrick disclose a system as recited in claim 1, and Eggleston further discloses that said databases are maintained and accessed by a central control computer integrally connected to said global information network (col 10, lines 4-6; col 11, line 65-col 12, line 11; Fig. 6; Fig. 2).

Claim 3: Eggleston and Dedrick disclose a system as recited in claim 1, and Eggleston further discloses that said global information network is the World Wide Web portion of the global Internet (col 5, lines 45-55).

Claim 4: Eggleston and Dedrick disclose a system as recited in claim 3, and Eggleston further discloses that said system is accessed by users through an Internet browser (col 8, lines 25-30).

Claim 5: Eggleston and Dedrick disclose a system as recited in claim 1, and Eggleston further discloses that the identifying information associated with each sweepstakes player comprises a plurality of discreet demographic descriptors (Fig. 16).

Claim 6: Eggleston and Dedrick disclose a system as recited in claim 5, and Eggleston further discloses that said advertising profiles are defined by a plurality of discreet demographic descriptors (col 31, lines 35-40; col 42, lines 35-40).

Claim 7: Eggleston and Dedrick disclose system as recited in claim 6, and Eggleston further discloses that the comparison of the identifying information related to each said sweepstakes player to each said target advertising profile is carried out through a comparison of the discreet demographic descriptors (col 31, lines 35-40; col 42, lines 35-40).

Claim 8: Eggleston and Dedrick disclose a system as recited in claim 1, and Eggleston further discloses that a selling price for each of said prizes is established by the associated prize presenter (col 15, lines 3-15; col 42, lines 33-40).

Claim 13: Eggleston and Dedrick disclose a method as recited in claim 12, and Eggleston further discloses that a predetermined sum is a paid to a presenter of said awarded prize (col 15, lines 7-15).

***Response to Arguments***

4. Applicant's arguments with respect to claims 1-14 have been considered but are not found persuasive.

Applicant has stated that there is no motivation to combine the Eggleston and Dedrick references.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Eggleston is directed towards providing incentive programs to promote products or services (col 1, lines 26-31). Eggleston is further directed to providing incentive programs to encourage viewing advertising, purchasing a product, increase product awareness, launch new products, differentiate products, obtain information, etc (col 1, lines 36-46).



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Eggleston's invention can operate on the Internet (col 1, lines 45-50). Eggleston further discloses targeting or profiling a user (col 42, lines 36-38; col 5, lines 26-36).

Dedrick is directed towards electronic information distribution networks and providing electronic advertisements to individual end users (col 1, lines 6-14) along with other types of information (col 3, lines 24-29). Dedrick is further directed to purchasing products because of advertisements (col 9, line 65-col 10, line 10). Dedrick further discloses targeting or profiling a user (col 1, lines 45-57; col 2, lines 1-10).

Hence Eggleston and Dedrick are analogous and related in their objects and intent. While Eggleston does disclose advertising, Dedrick expounds upon the advertising aspects of promotions. While Dedrick discloses purchasing products and advertising, Eggleston expounds upon the incentives as a way to enhance advertising response and the purchasing of a product. Therefore, Eggleston and Dedrick are directed towards many of the same objects and it would be obvious to combine Eggleston and Dedrick in order to enhance the capabilities already present in each reference.

Furthermore, Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety that is being referred to.

Furthermore, Examiner notes that it is not a 35 USC 102 rejection that was made with either Eggleston or Dedrick. Rather, a 35 USC 103 rejection utilizing Eggleston and Dedrick was made for all claims. Examiner admits that Eggleston or Dedrick alone do not disclose all the Applicant's features. Rather, it is the combination of Eggleston and Dedrick that disclose the Applicant's invention as stated in the claims. Hence, the combination of Eggleston and Dedrick must be considered as the prior art for every claim.

Additionally, 35 USC 103 rejections were made utilizing Eggelston. That is, based upon the entirety of Eggelston's disclosure, it would have been obvious to one skilled in the art to modify Eggelston's invention in certain ways.

Additionally, on page 9 of the Applicant's Amendment date 12/10/03, Applicant states, "neither reference provides for the comparison of 'the identifying information related to said sweepstakes player stored and maintained in said first database. . .to the target advertising profiles stored and maintained in said third database' such that 'said user is directed to a specific advertisement of a particular advertiser registered with the system based on said comparison'. . .neither reference provides that the 'sweepstakes is conducted to distribute the particular prize once a predetermined revenue has been generated by the directing of users to advertisements.'"

However, Dedrick discloses comparing identifying information of the user to target advertising profiles (col 2, lines 1-20; col 1, lines 45-58) and Eggelston discloses that the user can be a sweepstakes player (col 13, lines 43-56). Dedrick further discloses that the user receives specific advertising based upon the comparison (Fig. 7a).

Eggelston does not explicitly disclose that the prize can be delivered once the cost of that prize or a surplus of that cost has been satisfied.

However, Eggelston further discloses distributing a particular prize once a predetermined threshold is met (col 30, line 65-col 31, line 5). Eggelston further discloses that prizes cost money (col 15, lines 6-15). Eggelston further discloses tracking sponsor expenses (col 39, lines 40-51).

Therefore, in light of Eggelston being able to charge for directing advertising as disclosed above, it would have been obvious to Eggelston to offer the prize once the cost of the prize has

been satisfied. One would have been motivated to do this so that the sponsor can assure that their expenses are well maintained.

On page 10-11, the Applicant states, "neither reference provides for . . .determining revenue due from each registered advertiser in proportion to the number of times a specific advertisement web site. . .was visited by. . .players."

However, Dedrick discloses pay per view charging to advertisers (col 13, lines 17-21) and Eggleston discloses that the user can visit a sponsor site as a recorded participating activity (col 27, lines 3-6).

On page 12, the Applicant states, "the references fail to teach or even suggest, "the selling price of each prize. . .[is] established by the prize presenter."

Eggleston further discloses that a retailer can be a prize presenter (col 20, lines 33-38; col 21, lines 13-20), that the retailer establishes the selling price of each prize (col 20, line 63-col 21, line 3; col 21, lines 20-24) and that a retailer can sell a prize (col 22, lines 15-19).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

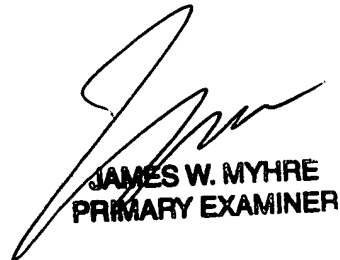
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

AD

12/16/03

  
JAMES W. MYHRE  
PRIMARY EXAMINER